

REMARKS

Claims 23-25, 27-30 and 32-40 are still pending; claims 1-22 and 26 and 31 have been cancelled.

The pending claims remain directed to a novel method of presenting a baseball game in a condensed fashion for viewing (and re-viewing) and for generating additional revenue.

Those skilled in the relevant art are well-versed in the conduct of a typical baseball game and with that understanding of a skilled worker, the pending claims are clear and definite. The claims are directed specifically to a method in which a baseball game (*e.g.*, an analog or digital recording thereof) is edited, such as on an inning-, or half-inning-by inning basis, or following the completion of the complete game, using a completely objective and reproducible procedure, to remove “substantially” all aspects of the pre-recorded game that do not directly impact the outcome of the game, *i.e.*, save for the outcome-determinative action associated with each batter that comes to the plate and a minor amount of additional content (such as between inning banter by the announcers, occasional crowd shots, or certain foul balls that may have fan interest). In this way, essentially all the action of an entire baseball game that is reflected in the box score for each participant in the game is consolidated or condensed into about 10-20 minutes of video.

As noted in earlier filings, applicants would like to again remind the Examiner that a Rule 131 declaration by the inventors was previously filed in this application. In this Declaration, the inventors swore behind a Major League Baseball (MLB) Press Release dated March 27, 2001, which announced an agreement between MLB Advanced Media and RealNetworks (this was done prior to the granting of applicants’ petition for a filing date which ultimately entitled them

to benefit of a June 13, 2000 provisional filing date). As documented in the declaration, prior to that time the inventors had disclosed their invention to a representative of MLB. It was only thereafter that MLB introduced an offering over their Intertnet site (website) using this invention for generating additional revenue.

Regrettably, the examination to which this application has been subjected has been unnecessarily repetitive. The application filed in June 2001, was first examined in May 2003. In that rejection, the Patent Office cited several video recording services and asserted "it would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences." In response to that rejection, applicants provided the above-noted Rule 131 declaration and other objective evidence of non-obviousness, including the adaptation of the invention by Major League Baseball in the form of its "Condensed Games" product offered to internet subscribers on the MLB website. A Notice of Allowance, dated February 24, 2004, followed that response.

Thereafter, the application was withdrawn from issue (notice dated 14 March 2005). The subsequent rejection cited several sports highlight video services along with substantially the same assertion that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have edited and recorded the video to reflect what the viewer wished to record based on personal preferences." Following a response filed on June 10, 2005, a Final Office Action issued. Hoping to save unnecessary expense, applicants pursued the then recently initiated Pre-Appeal Brief Review procedure. While successful in having the final action withdrawn, the Patent Office merely started the examination process over once again, so no

expense has been saved. Indeed, the cost is now multiplied as applicants must pursue another round of prosecution.

Like the earlier actions, the current action again relies on a sport's highlight video program and once again asserts that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences and time available." We are back to where we started almost three years ago. Preparing a highlight show is not applicants' invention and does not suggest applicants' invention.

Claims 23-26, 28-31, 33-35 and 37-40 now stand rejected under 35 U.S.C. 103(a) as being unpatentable over ProQuest-Producing Sports Channel (ProQuest) and the remaining claims 27, 32 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over ProQuest in view of MediaChannel. These rejections are respectfully traversed.

In the current rejections, the Office Action impermissibly considers the teachings (if they can be characterized as that) of the ProQuest citation with the gloss of hindsight from having already taken aim at applicants' claimed invention. The Office Action asserts that "ProQuest discloses an edited baseball game provided to subscribers." But nothing in ProQuest demonstrates that it is anything more than a baseball highlight show – calling it an edited baseball game does not change that immutable fact. Indeed, the cited page apparently taken from an on-line copy of the *San Francisco Chronicle* expressly characterizes the program as a "highlight" show. Applicants' claimed invention is NOT the production of a highlight show!! In stark contrast, the claimed method is an objective procedure for producing a specific edited

version of a baseball game in which every batter's appearance at the plate is shown, where that appearance is edited such that the resulting video consists essentially of the last pitch to each batter and that edited video is broadcast. That process does not produce a "highlight" program.

While ProQuest may be starting with the same raw footage of a baseball game that then is edited to produce its highlight package, the editing that is done to produce a highlight package and the editing that is expressly required by the claimed invention are not the same thing. The Office Action's contention that "to have selected an appropriate number of action shots" ... "in order to permit the edited video to be broadcast in an allotted time," does not embrace applicants' claimed invention. The Office Action again lapses into the assertion that how the entire footage of the baseball game is edited is simply a matter of choice. Indeed, this is the essence of the rejection.

A highlight show edits a baseball game according to the **subjective** whims of the individual doing the editing, to a consolidation of those aspects or action footage of the original video that the individual **subjectively** decides is worth showing in the "highlight" program. The present invention, in a completely different manner, requires a totally **objective** treatment of the baseball game. The product of the method does not change depending on who is assigned the task of editing the video. The resulting video program consists essentially of (i) the final pitch thrown to every batter and any game action resulting from the final pitch, (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch. From

game to game, the original game footage is edited in the same manner. The editing is not varied based on the bias or interests of person doing the editing and is not influenced by the nature of the game itself (its length, the number of hits made or runs scored). The claimed method is not simply a matter of choice that varies from one time to another. Nothing in the prior art's production of a "highlight" show provides any suggestion of the radically different approach embraced by the claimed method.

As was done in previous rejections, the Office Action repeatedly asserts that the specification "provides no unexpected results" in recording the action plays of the game. This comment illustrates the Office Action's attempt to shift the burden of demonstrating patentability to applicants. It is the burden of the Patent and Trademark Office (PTO) to present a *prima facie* case of obviousness of the invention defined by applicants' claims, it is not applicants' burden to show the "criticality" or "unexpected results" of the invention, unless and until the PTO *prima facie* shows that the invention (method) would have been obvious to a person of ordinary skill in the art. As demonstrated, the rejection does NOT present a *prima facie* case of obviousness.

As noted above, the essence of the Office Action is the contention that deciding what portion of a pre-recorded video of a baseball game to select (or edit) is simply a design choice ("editing decisions"). But, the exercise of a design choice is at the heart of any invention that involves a new way of using established technology. When that choice is a non-obvious choice, as is the case with the present invention, then the requirement for patentability is satisfied. The Office Action's approach to assessing patentability ignores the proper method for determining the issue of non-obviousness established by the U.S. Supreme Court in *Graham v. Deere*.

In the present case, the claimed method involves an objective, pre-selection of the content of the edited recording that breathes patentability into the invention – the attempt in the Office Action to denigrate that novel and nonobvious selection of content as simply a matter of design choice is based completely on an improper hindsight evaluation of the claimed invention.

The proper question, when addressing the issue of patentability, is whether it would have been obvious to a skilled worker to use the known technology in the manner embraced by the pending method claims. The fact that the invention is one of an infinite numbers of “choices” that confronts a worker of ordinary skill, when using such established technology to edit a video recording, is of no moment. It is only when illuminated by the improper light of hindsight that the present invention would in any way be considered by a skilled worker.

The invention is NOT directed to simply making a “highlight” tape of a baseball game, as for example one might see on ESPN’s SportCenter and as the ProQuest production clearly involved. Rather, the invention is directed to a particular pre-selected and thus objective method of editing a pre-recorded baseball game to show essentially all of and essentially only all of the outcome-determinative pitches to each batter; while substantially eliminating all non-outcome-determinative action from the edited recording. In this way the edited video shows substantially only the outcome of each at bat in the game (all of the “pay-off pitches”), such as the strike-out pitch, the base hit, the home run, the hit batter, the ground out, the fly out, the double play ball, etc. Obviously, such a record is not merely a highlight reel – indeed much of the action required to be included by applicants’ claimed invention would not even be considered a highlight.

The concept of making a highlight tape does not suggest making such a pre-selected,

edited record of an entire baseball game in the manner defined by the pending claims.

Thus, when one assesses the differences between the cited prior art and the subject matter defined by the pending claims, as required by *Graham v. Deere*, one sees that the actual content of the potential recordings is substantially different. A set of highlights, as practiced by the prior art (ProQuest included), captures only a few to possibly a couple dozen events in the course of a game, and generally represents a subjective assessment of those aspects of the game that a viewer might find particularly interesting. The present invention, in contrast, establishes an objective, pre-selection of the game action to be included, selecting essentially all of the game action that contributes to the box score of the game. In a nine inning baseball game this would require at a minimum 54 pitches, with a typical number being about 70-85 (and the resulting game action).

There is nothing in the prior art cited by the Examiner that in any way suggests that one could predicate a new business method, *i.e.*, produce a new product, that would be in demand, *i.e.*, have intrinsic value, **independent of common highlight videos** by capturing the action of a baseball game in this manner, *i.e.*, by distilling the recording of a baseball game down to essentially only those actions that contribute directly to the outcome of the contest, such as the result that occurs following the last pitch thrown to each batter for each turn at the plate, or the tagging out or safe advancement of a base runner as may occur in a pick-off play or if the runner is caught stealing.

Based on applicants' teachings, anyone with even a rudimentary knowledge of the game of baseball can envision what aspects of the pre-recorded game to exclude and what to retain in

the editing process to accomplish the stated result – there is nothing subjective in carrying out the claimed method.

However, before the disclosure of applicants' teachings, there is not one shred of evidence that those of ordinary skill would have envisioned conducting such a method and preparing such a product. The prior art always focused on the subjective selection of game action in the nature of a highlight show. That is not applicants' invention.

Of course, one can, within the spirit of this invention, include a minor amount of extraneous recorded information in the edited version according to the present invention, *e.g.*, a video clip of a young fan watching the game, or a video clip of a coach or manager giving signals or changing the pitcher, so as to accent the summary presentation provided by this invention. Thus, the use of such words as "essentially" and "substantially," which the Federal Circuit has repeatedly acknowledged are terms implying approximation not exactness, to modify certain aspects of the claimed method, prevents one from slavishly limiting the literal scope of the method to the essential actions. The objective of the invention is to present a complete summary of the action that is recorded in the original game, as reflected in the box score for each participant in the game, so that the action is consolidated into about 10-20 minutes of video.

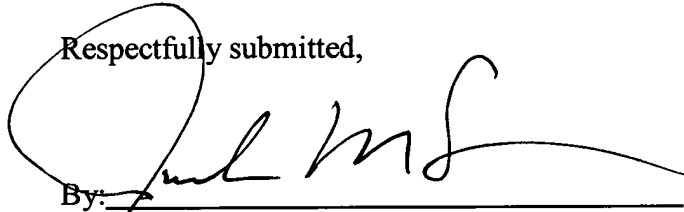
Indeed, if the claimed method was simply an obvious design choice, why then did Major League Baseball call it "revolutionary" when it first introduced its offering of "Condensed Games." "Major League Baseball (MLB) today announced the debut of a revolutionary new baseball video service." (Press Release of March 5, 2002 – copy previously submitted with August 27, 2003 Information Disclosure Statement). MLB's own glowing characterization of this

method of doing business stands as a powerful testament of the non-obviousness of the claimed method. This objective indication of the non-obviousness of the method must be considered when evaluating the patentability of the claimed method. The adoption by MLB of this business method (see also the enclosed copy of MLB's web page from May 2002 using the term "pay-off pitch" to describe the product available for \$4.95/month) decades after pre-recording of baseball games was begun and years after the technology of providing such a product/service over the internet was available, stands as an uncontested tribute to the ingenuity and inventiveness of the claimed method. We submit that such third party commentary unequivocally demonstrates the patentability of the subject matter defined by the pending claims.

The citation of the secondary reference MediaChannel does not address any of the glaring shortcomings of the primary reference. While MediaChannel provides video clips for sale nothing regarding a baseball-related product of the type embraced by the pending claims is mentioned.

On the basis of the foregoing, prompt consideration and an allowance of all claims in the subject application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. M. Skerpon', written over a horizontal line.

By: _____

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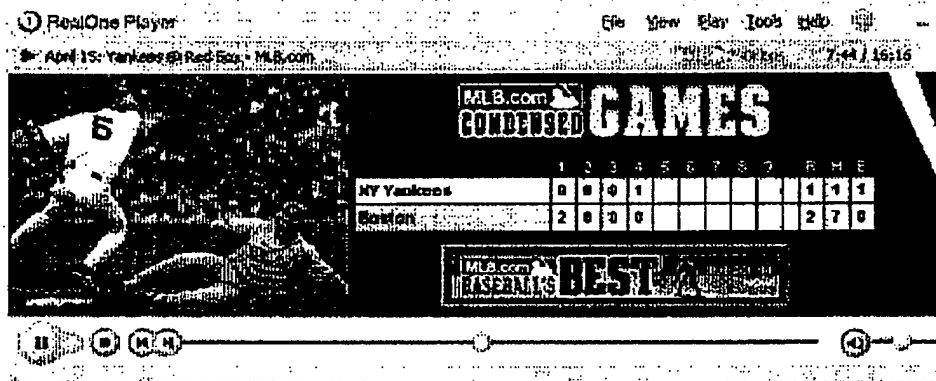
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